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10/568,101

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EXAMINER

WILDER, CYNTHIA B

ART UNIT

PAPER NUMBER

1637

NOTIFICATION DATE

DELIVERY MODE

09/25/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/568,101 | Applicant(s) MORI ET AL. | |
| | Examiner CYNTHIA B. WILDER | Art Unit 1637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-18,20,22 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 4-18, 20, 22, 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/2008 has been entered. Claims 1, 4, 22, 25 have been amended. Claim 3, 19, 21, 23-24, and 35-36 have been amended. Claims 1-2, 4-18, 20, 22, 25-34 are pending.

Declaration under 37 CFR 1.132

2. The declaration under 37 CFR 1.132 filed 6/16/2008 is sufficient to overcome the 103 rejection of claims 1-2, 4-18, 20, 22, 25-34 as being unpatentable over Su I in view of Su II in view of Kappel et al and further in view Sigma Data Sheet. The declaration provides evidence of unexpected results using an alcohol-base antifoaming agent, in particularly Acetylene glycol, in the isolation and purification method. The declaration provides evidence of a substantial increase in separation and purification of DNA with a smaller foam size (see Table at page 5). The cited prior art does not teach does not teach using an alcohol-base antifoaming agent and further does not teach the degree of separation and purification of nucleic acid as shown by the Declaration.

Previous Rejections

3. The prior art rejection under 35 USC 103(a) as being unpatentable over Su I in view of Su II in view of Kappel et al and further in view Sigma Data Sheet is withdrawn in view of Applicant's Declaration under 37 CFR 1.132 showing unexpected results in the use of an alcohol type antifoaming agent, in particularly acetylene glycol, for separating and purifying a nucleic acid. The double patenting rejection is withdrawn in part. Specifically, the provisional double patenting rejection against the 10/974681 application is withdrawn in view of Applicant's arguments. The remainder of the double patenting rejections are maintained and discussed below. The double patenting rejections are modified to address the amendment of the claim 1.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2, 4-18, 20, 22, 25-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10209336 in view of Herman Mark (Encyclopedia of Polymer Science and Technology, vol. 1, pages 670-739, February 2003) and further in view of Kappel (citation made of record above).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1-2, 4-18, 20, 22, 25-34 of the instant invention and the claims 1-38 of copending application '336 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid. The claims are drawn to saponification treatment (see instant claims 15-17) and also to a unit and cartridge for use in isolating and purifying the nucleic acid.

The claims 1-38 of copending application '336 only differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

6. Claims 1, 26 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending

Application No. 10305110 in view of Herman Mark (citation noted above at #5) and further in view of Kappel (citation made of record in prior Office actions).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1, 26 and 27 of the instant invention and the claims 1-3 of copending application '110 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid. The claims are also drawn to a unit for use in isolating and purifying the nucleic acid.

The claims 1-3 of copending application '110 only differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that

does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

7. Claims 1 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 10621329 in view of Herman Mark (citation noted above at #5) and further in view of Kappel (citation made of record in prior Office action).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1 and 22 of the instant invention and the claims 1 of copending application '329 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid. The claims are also drawn to the thickness of the membrane (see instant claim 22).

The claim 1 of copending application '329 only differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel

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teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

8. Claims 1-2, 4-18, 20, 22, 25-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/621715 in view of Herman Mark (Citation noted above at #5) and further in view of Kappel (citation made of record in prior Office actions).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1-34 of the instant invention and the claims 1-19 of copending application '715 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from

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the solid phase and recovering the nucleic acid and saponification treatment (instant claims 15-17). The claims are also drawn to a unit and cartridge for use in isolating and purifying the nucleic acid.

The claims 1-19 of copending application '715 only differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

9. Claims 1-2, 4-18, 20, 22, 25-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-17 of copending Application No. 11217339 in view of Herman Mark and further in view of Kappel as previously applied above.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1-34 of the instant invention and the claims 1-5 and 10-15 of copending application '339 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid.

The claims 1-5 and 10-17 of copending application '339 only differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that

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does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

10. Claims 1-2, 4018, 20, 22, 25-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 10/975469 in view of Herman Mark and further in view of Kappel as previously applied above.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 1-34 of the instant invention and the claims 1-35 of copending application '469 are broadly drawn to isolating and purifying nucleic acid by absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid. The claims are also drawn to a unit and cartridge for use in isolating and purifying the nucleic acid.

The claims 1-35 of copending application '469 differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel

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teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

11. Claims 26-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 10932138 in view of Herman Mark and further in view of Kappel as previously applied above.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F. 2d 887, 225 USPQ 645 (fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim of the instant invention 26-31 and the claim 1 of copending application "138 are drawn to isolating and purifying nucleic acid by

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absorbing the nucleic acid to a solid phase and desorbing the nucleic acid from the solid phase and recovering the nucleic acid, wherein a unit and/or cartridge is use to carry out the method of isolating and purifying the nucleic acid.

The claim 1 of copending application '138 differs from the instant invention in that they do not recite wherein the nucleic acid comprises an antifoaming agent, wherein said antifoaming agent is an alcohol type antifoaming agent.

Herman Mark provides a general teaching wherein an alcohol-base antifoaming agent is discussed. Herman Mark teaches that acetylene glycol is a surfactant that does not increase the viscosity of the surface of foam bubbles (page 731, col. 1, section entitled "Foaming").

Kappel et al teach a method and apparatus for solid phase lysis and capture of nucleic acids. Kappel teach wherein a lytic reagent is added to cells to extract the nucleic acid, said reagent comprises may comprise a chaotropic agent, buffer, bulking agent, process enzymes, enzymatic inhibitors or an antifoaming agent (0109). Kappel teaches that the antifoaming agent is added to prevent excessive foaming or frothing during lysis (0117).

Therefore, one of ordinary skill in the art at the time of the claimed invention would have been motivated to have encompassed antifoaming agents as those taught by Mark and Kappel in the isolation and purification methods for the obvious benefit of preventing excessive foaming or frothing as taught by Mark and Kappel.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

12. Applicant traverses the rejection on the grounds that the claims are amended and thus obviates the double patenting rejection. Applicant also asserts that an issue of Notice of Allowance is rejected in this case and thus any possible double patenting issues should be addressed in the co-pending applications.

All of the arguments have been thoroughly reviewed and considered but are not found persuasive because the instant invention is not deemed in condition for allowance based on the new grounds of rejections discussed below. Additionally, it is noted that the amendment did not obviate the double patenting rejections against the copending application for the reasons discussed above. Likewise, since it cannot be determine which application may be issued first, the double patenting rejections in this case are deemed valid.

New Ground(s) of Rejections

***THE NEW GROUND(S) OF REJECTIONS WERE NECESSITATED BY APPLICANT'S
AMENDMENT OF THE CLAIMS:***

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-2, 4-18, 20, 22, 25-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(a) Claims 1-2, 4-18, 20, 22 and 25-34 are indefinite at the recitation of "higher alcohols" in the claim 1 because it cannot be determined from the specification or claims what alcoholic structures would be effective as an antifoaming agent. The term "higher alcohol" encompasses any alcoholic structure comprising more than 2 carbons. However, the specification does not provide any limiting definition which would allow one to determine the metes and bounds of the limitation as it functions in the instant invention. Clarification is required.

Conclusion

15. No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CYNTHIA B. WILDER whose telephone number is (571)272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia B. Wilder/
Examiner
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